

Appl. No.: 09/827,504  
Amdt. Dated: 08/26/2005  
Off. Act. Dated: 05/26/2005

### **REMARKS/ARGUMENTS**

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. **Rejection of Claims 1-25 and 32 under 35 U.S.C. §112, first paragraph.**

Claims 1-25 and 32 were rejected under 35 U.S.C. §112, first paragraph as being indefinite.

(a) In Claims 1-25 and 32, the Examiner objected to the phrase "*wherein said time is after a start time of said content and said time is before an end time for said content*", as not being disclosed in the specification as originally filed.

Applicant concurs that the specific "wording" above is not found in the specification, however, it is implicit in a data marking device. To enter a mark either before or after the content would equate to marking the content that either preceded or followed the content which was marked. The background of the invention discloses that e-marker devices have been introduced by the corporation of the assignee and discusses what data marker device perform. In addition references to prior filed patents are incorporated herein by reference - one of which directs attention to what has now issued as the Deguchi patent (U.S. Pat. No. 6,578,047).

The phrase was added in an attempt to aid the Examiner in the interpretation of the claims. However, aspects of a data marking device should be clear enough in the claims themselves. If Examiner has suggestions on how he would like this aspect clarified, then Applicant would welcome any constructive suggestion.

2. **Rejection of Claims 20-22, 24-25 and 26-31 under 35 U.S.C. § 103(a).**

Claims 20-22, 24-25 and 26-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Deguchi (U.S. No. 6,578,047).

Applicant submitted in May 14, 2004 an affidavit under 37 CFR 1.131 as evidence that the Deguchi reference is not prior art, but was subject to common

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assignment with the instant application. (A copy of this Affidavit is included in the appendix).

However, Examiner made no reference to the affidavit in the subsequent office action dated August 25, 2004; and continued despite evidence to the contrary to treat Deguchi as prior art.

Then in the November 12, 2004 response the Applicant reminded the Examiner of the affidavit filed in May 2004.

Again, the Examiner missed or ignored the reminder about Deguchi not being a prior art reference, and made the rejection final based in large part on the Deguchi reference. The action was improperly made final.

Referring to MPEP 706.02(I)(3)(C) The reference was used in an obviousness rejection under 35 U.S.C. 103(a).

*"Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization."*

Further information can be found as the rejection under 103(a) relates to a classifications of 102(f) or 102(g) under 35 U.S.C. § 102 - *"(f) he did not himself invent the subject matter sought to be patented, or (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."*

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Wherein referring to MPEP Section 7.15.01 describes "Provisional Rejection, 35 U.S.C. 102(e) - Common Assignee or At Least One Common Inventor"

*"Claim [1] provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. [2] which has a common [3] with the instant application.*

*Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. [4].*

*This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. "*

Accordingly, the Affidavit submitted should be sufficient to overcome Deguchi as a prior art reference.

IF ANY ISSUE still exists with recognition of the common assignment of the Deguchi patent based on the affidavit in the present response, then applicant respectfully requests that Examiner call Applicant's counsel regarding this matter, prior to sending of a new office action. This matter needs to be discussed either between Examiner and Applicant's Counsel, or with a conference including the parties and the Supervisory Examiner.

3. Rejection of Claims 1-11, 14-16 and 32 under 35 U.S.C. § 103(a).

Claims 1-11, 14-16 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie et al (U.S. No. 5,850,218), in view of Wilmore (U.S. Pat. No. 6,680,714).

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Claims 1 and 32. Independent Claims 1 and 32 recite "*An electronic data marker device*" and "*An electronic marker device*" in their respective preambles.

The rejection suffers from a number of shortcomings, including: non-analogous art, rejection based only on similarity of inventive concept or idea, new principle of operation utilized, solved a different problem, lack of specificity of suggestion to modify, "plain meaning" of recited elements ignored, elements in references are not equivalent, references do not add up to the invention, all claim limitations are not taught, unworkable combination, useless combination, impossible to combine, proposed combination renders reference unsuited for intended purpose, no need of element within references, unsuggested combination, no motivation to combine, modification based on hindsight in view of applicant's teaching, obvious to try is not a standard of obviousness, invention was not considered as a whole, and overall No Prima Facie Case of Obvious has been established.

It should be noted that the presence of ANY of the these shortcomings is sufficient to overcome the rejection, while the presence of ALL of these shortcomings is overwhelming evidence for patentability. In view of the large number of problems with the rejection and for the sake of efficiency, the following focuses on a few of these intractable shortcomings.

#### **NON-ANALAGOUS ART &**

##### **REJECTION BASED ONLY ON SIMILARITY OF INVENTIVE CONCEPT**

Neither the LaJoie, or Wilmore reference has any relation to a data marking device as specified in Applicant claims.

LaJoie teaches "a system and method for providing a full service cable television system" (See first line of Abstract in LaJoie). There is no teaching which comports with or relates to an electronic data marker device as recited in the claims. Elements in the system are described as "a cable headend, at least one fiber transport, at least one

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distribution hub, at least one hybrid fiber coax plant, and a plurality of set-top terminals" (see 3<sup>rd</sup> sentence in LaJoie Abstract). Nothing of this ilk has any relation to the claimed elements of Applicant's invention.

Wilmore is entitled "Interactive Multi-User Display Arrangement for Displaying Goods and Services" is drawn to multi-monitor display system. The purpose of the invention is described as: "It is accordingly the object of the present invention to provide a video wall holding a matrix of matrices of video display monitors, screens or the like, and a row of terminals..." (see col. 1, lines 36-38 of Wilmore).

MPEP: "TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART. In order to rely on a reference as a basis for rejection of an applicant's invention the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."

The MPEP recites the case of *Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case a garment fastener was dismissed as non-analogous in relation to a hose clamp. The court held that: "*the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.*"

Neither reference is directed at a data marking device. Neither reference appears to offer any motivation for one of ordinary skill in the art working on the problem of setting data marks corresponding with broadcast content for getting information about that content.

General similarities with LaJoie having set times within program guide, and Wilmore having a display with sections, is not supportive of the obviousness rejection.

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### **NEW PRINCIPLE OF OPERATION UTILIZED & SOLVED A DIFFERENT PROBLEM**

The references do not share the same principles of operation, or problem to be solved, with each other or the claims of the instant application.

The problem being solved by LaJoie is as follows: "*It is therefore an object of this invention to provide a full service television system capable of delivering a high number of high quality television signals*". The text and drawings go on to recite the television system in greater detail. LaJoie includes description of a programming guide, however, it will be readily understood by anyone of ordinary skill in the art that a programming guide is configured to allow a user to select a desired content for viewing or recording. If the content is to be recorded then a start and stop time are associated with the guide selection. This has no relation to the problem being solved in the instant application. In addition the principles of operation of a cable television network have no relation to operating a device for generating data marks associated with content.

The problem solved by Wilmore relates to being able to generate a huge display from a number of individual displays. This problem does not relate to the problem being solved by the Applicant. The principles of operation relate to display driving as seen in FIG. 1 with a multiplexer for selecting video display elements within the video display. This also does not relate to the display means.

MPEP 2143.01A:

**"THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE** If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)"

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MPEP 2143.01A: "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, **and the nature of the problem to be solved as a whole** would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." Emphasis added. No mention is made as to what the Examiner considers to be the "Data marker device"

Consequently, the relied upon references fail in both the objects and the principles of operation.

**"PLAIN MEANING" OF RECITED ELEMENTS IGNORED &  
ELEMENTS IN REFERENCES ARE NOT EQUIVALENT**

In support of the rejection the Examiner puts forth that LaJoie:

*"..teach s display unit including a plurality of windows (see, figs.14, 16) an electronic data mark device comprising: an input unit for inputting data marks wherein each said data mark indicates time and content of broadcasted (see, fig.16 [346]; [348]; [350]); said display unit is configured to receive said data marks from said input unit and correspondingly display said data makes on said plurality of windows (see, fig.16 [340]; [346]; [350])."*

However, the teachings of LaJoie do not comport to those as recited in the claims of the instant application. Looking at the referred upon portions of LaJoie:

Considering, fig.16 [346]; [348]; [350], of LaJoie is shown a "program guide of a set top box". Referring to column 23, lines 48-49 this portion of FIG. 16 is described: "FIG. 16 illustrates the time mode of interactive program guide (IPG) ...a highlighted

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*program summary 346, a guide data and time bar 348, a channel list 350...*

In attempting to construe the claim elements in this manner Examiner is ignoring the plain meaning of the terms used in the claims, and their meaning in relation to the specification and what is known about e-marker devices, such as described in the references incorporated by reference. A program guide is a means of showing what has or will be broadcast, there is clearly no need for a data marking device when the information about the broadcast is contained in the program guide!

The claim term "data mark" has a meaning which is known in relation to class of devices described by the claim, such as within the preamble which specifically describes a "*data marking device*". In a data marking device a mark is made during a broadcast, on a device not associated with the broadcast (if associated then no need for marking), wherein the data mark allows information about the broadcast to be subsequently looked up. Yet, the term is improperly taken as being just a time reference associated with broadcasts.

The "*display means for displaying said plurality of data marks*" is similarly misconstrued as elements [340]; [346]; [350] in Fig. 16 of LaJoie. However, these are seen as a 340 "*program viewing window*", 346 "*program summary*", and 350 "*channel list*". Again although these do display information about broadcasts they do not display data marks, or the information retrieved for the specific data marks.

The rejection then relies on the Wilmore reference to teach a display with a plurality of display panels. However, again the plain meaning as recited in the claims are being ignored. The display unit "*is configured to receive said data marks*" and the claims also states that it is to "*display said data marks on said plurality of display panels*". Wilmore is not related to a data marking device; it does not receive data marks, nor does it display data marks as that term is known in the claims and specification of the instant application.



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Accordingly, the relied upon references have only general similarity to portions of the claimed invention.

### **Not All Claim Limitations are Taught**

Core limitations regarding the "Data mark" have been wholly ignored. Neither reference has any relation to an electronic data marking device, which is necessary in view of both the claim elements and the preamble which connotes the device to be of the group of devices known as an "electronic data marker device".

Neither of the references have anything at all to do with data marking devices, and do not teach this core limitation.

### **MPEP 2143.03 All Claim Limitations Must Be Taught or Suggested**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (emphasis added)

### **PROBLEMS WITH ASSERTING COMBINATION**

The attempt to make the combination itself suffers from numerous problems. The **combination is unworkable** - combining LaJoie with Wilmore does not create a data marking device with the recited attributes. The **combination is useless** - it only augments the cable TV system with programming guide by allowing it to be displayed over multiple screen; this has no bearing on the instant application. The **proposed combination renders reference unsuited for intended purpose** - as mentioned adding the multipanel display screen does nothing to change the system of LaJoie into a data marker; while even attempting additional combinations with LaJoie to incorporate data marker aspects would necessarily change the cable TV system described therein.

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**No need of element within references** - there is no need of a multipanel display screen in LaJoie, and there is even less need for adding an additional reference described a data mark. **No Suggestion or Motivation to combine** is found in either reference and nothing is put forth as why one would even attempt such a useless combination. **Invention was not considered as a whole.** It is clear from the piecemeal approach taken that the invention was not considered as a whole. This is also clearly brought out in that the primary core of the invention is not shared with the LaJoie reference.

#### **NO PRIMA FACIE CASE OF OBVIOUS HAS BEEN ESTABLISHED**

In view of the above it is clear that no prima facie case of obviousness has been established, as each and every claim reference has not been shown to be obvious. The criterion for the prima facie obviousness is well understood by practitioners and is well stated in an appeal judgment (Appeal No. 1998-1073 Application 08/488,521):

"It is well settled that a prima facie case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. See generally, In re Rouffet, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); In re Oetiker, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); In re Fine, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)" (Emphasis added)

Therefore, there is a lack of support for the obviousness rejection, wherein the rejection of independent Claims 1 and 32, as well as for the claims which depend therefrom should be withdrawn.

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4. Amendment of Claims 1 and 32.

Claims 1 and 32. The phrase "*wherein said time is after a start time of said content and said time is before an end time for said content*", was removed in these claims in response to Examiner objection.

5. Copy of Affidavit Submitted Previously.

Appendix contains a copy of the Affidavit submitted May 14, 2004.

6. Request for Continued Examination.

A proper fee is enclosed for a Request for Continued Examination (RCE) of this case under 37 CFR 1.114.

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7. Conclusion.

Applicant respectfully requests that the common assignment of the Deguchi patent be properly considered, and those claims rejected in view of the Deguchi reference be allowed.

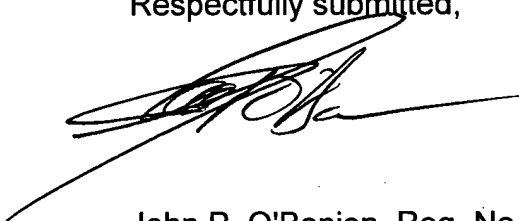
In addition, based on the foregoing discussions Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present Application to pass to issuance.

In the event any further matters remain at issue with respect to the present Application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this Application, ...AND PLEASE CONTACT THE UNDERSIGNED IF ANY PROBLEM REMAINS RELATING TO THE COMMON ASSIGNMENT.

Date: \_\_\_\_\_

8/26/05

Respectfully submitted,



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**CERTIFICATION UNDER 37 CFR 1.8**

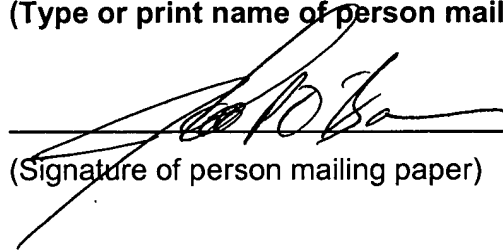
I hereby certify that the foregoing:

Amendment

is being deposited with the United States Postal Service on August 26, 2005  
\_\_\_\_\_ with sufficient postage as first class mail in an envelope addressed  
to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

\_\_\_\_\_  
JOHN P. O'BANION

(Type or print name of person mailing paper)

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(Signature of person mailing paper)